

REMARKS

The applicants have elected the invention of claims 1, 3-7, 19-27, 31, 32, 65, 93-101, 126, 130-133, 135-143, and 169-174. Claims 1-174 remain in the application.

Claims 1 and 14 are amended to rectify manifest informalities. The amendments are voluntary and are not in response to objections or rejections. Neither claim is amended for reasons related to patentability or prior art.

Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143, and 169-174 are provisionally rejected for obviousness-type double patenting over various claims of co-pending, commonly-owned applications 09/679,039, 09/679,038, 09/728,693, 09/668,553, 09/668,331, 09/668,632, 09/668,515, 09/668,631, and 09/668,600. As no claim of any one of those applications has yet been allowed, the applicants respectfully reserve response to these rejections without waiving any right to respond to those rejections while they remain provisional.

Claims 1, 3-7, 19, 20, 24, 25, and 93-98 are rejected for anticipation by US Patent 5,848, 397 ("Marsh"). That rejection is respectfully traversed for the following reasons.

Claim 1 recites a "playlist server system" that supplies a playlist response to a client device exchanging information with an information server system over a communications network and storing ads. The playlist server system includes:

"playlist response generating means for generating a playlist response identifying a plurality of selected ads to be presented by the client device; and

first communications means for establishing a playlist response send communications link with the client device via the communications network over which the playlist response is transmitted to the client device,

wherein the information server system and the playlist server system are independently controlled."

In order for Marsh to anticipate these claims, every element and limitation of the recited "playlist server system" must be explicitly taught by Marsh, or be inherent in the message scheduling method and apparatus described by Marsh. Marsh must also enable the "playlist server system".

The claimed invention is a "playlist server system" for supplying a PlayList Response to a client device exchanging information with an information server system over a communications network and storing ads. More specifically, the software

instantiates a PlayList Response generation function for generating a PlayList Response identifying a plurality of selected ads to be presented by the client device. See the enabling description of a playlist server (PLS) in the specification at page 54, line 6 through page 58, line 23.

According to the specification at page 43, line 10 through page 44, line 1, a “playlist response” includes a data structure with a client information section “which updates general client behavior regarding ads, i.e., speed with which the ads turn over,” and a playlist, “which describes the ads the client should fetch.”

The “playlist” is “in its essence a list of URNs from which to fetch the actual ads as well as a set of attribute-value pairs, on a per-ad basis. The exact format of the PlayList is discussed in greater detail shortly. PlayLists will specify the complete set of ads the client should have, along with parameters for displaying those ads.” See the specification at page 36, lines 4-13.

The terms “playlist”, “playlist server”, and “playlist response” have been explicitly defined in the specification. The applicants’ disclosure must be relied on to determine the meanings of these terms. See MPEP 2106. The examiner may give *claims* (not the elements of claims) their broadest reasonable interpretation *in light of the supporting disclosure*. That is to say, the examiner may give claims 1, 3-7, 19, 20, 24, 25, and 93-98 their broadest reasonable interpretation, but that interpretation must be in light of the meanings given the terms “playlist”, “playlist server”, and “playlist response” in the supporting disclosure.

According to the rejected claims, a “playlist server system” prepares and transmits a “playlist response identifying a plurality of selected ads to be presented by the client device”. The contention in the Office Action is that Marsh teaches a “playlist server system” that generates a “playlist response” in FIG. 8 and at col. 15, lines 1-10. The applicants respectfully disagree.

In Marsh, advertisements are selected by, obtained by, and downloaded from a mail server in a server system 104 that is “an electronic mail (e-mail) system which functions as an electronic post office.” See Marsh at col. 6, lines 15-17. Further, Marsh teaches that only advertisements are downloaded, not a list of advertisements. Marsh does not teach that the e-mail server system functions to provide a “playlist response” identifying selected advertisements to be presented by a client device, which is one of the functions of the “playlist server system.” At col. 15, lines 1-10, Marsh describes a “statistics log file” that is kept by a client system 101. This data structure includes

information as to when and for how long ads are displayed at the client system. The statistics log file is transmitted by the client to the electronic mail server system 104 to be used for “billing and reporting services.” Marsh says “this information” can also be used by the advertisement distribution scheduler and the advertisement download scheduler, but does not say of what “this information” consists, or how the advertisement distribution scheduler and the advertisement download scheduler use it. The statistics log file is not evidently a “playlist” or a “playlist response” because it is not sent by a server to the client system, and also because it does not identify “a plurality of selected ads to be presented by the client device.” Indeed, at col. 15, lines 1-10, Marsh omits any response by any server system “identifying a plurality of selected ads to be presented by the client device” that is transmitted to a client device. Accordingly, Marsh omits a “playlist server system” that includes “playlist response generating means for generating a playlist response identifying a plurality of selected ads to be presented by the client device,” and “first communications means for establishing a playlist response send communications link with the client device via the communications network over which the playlist response is transmitted to the client device.”

The further contention in the Office Action is that Marsh teaches “wherein the information server system and the playlist server are independently controlled” at col. 13, line 56 through col. 14, line 63. The applicants respectfully disagree. As claim 1 recites, the “playlist server” supplies the playlist response to the client device while the client device is “exchanging information with an information server system.” In light of the supporting disclosure the “playlist server system” and the “information server system” are distinct entities. In the cited passage, Marsh describes the e-mail server system 104 and specifies that it “may transmit new banner advertisements and/or showcase advertisements to the client system.” The passage also describes “an advertiser 108” from which the e-mail server system may receive advertisements. However, there is only one server system described in Marsh at col. 13, line 56 through col. 14, line 63, and that server system is an e-mail server system, not a “playlist server system.” Since Marsh does not describe two server systems, there is no basis for “independently controlled” server systems. Accordingly, Marsh omits “wherein the information server system and the playlist server are independently controlled.”

With respect to claims 3-7, 19, 20, and 93-98, the contention is that Marsh teaches a playlist function that “merges the current playlist with the current new playlist” at col. 15, lines 2-13. The applicants respectfully disagree. This passage describes a

statistics log file in which the frequency and duration of advertisement display is recorded by the advertisement display scheduler in the client device. In this passage, no new and old, or current and new, statistics log file is described, no statistics log file replaces any other statistics log file, and no “playlist”, old or new is described. Accordingly, Marsh omits any playlist response that comprises a new playlist, any playlist currently employed by the client device that comprises a current playlist, and the replacement of the current playlist by the new playlist when the client device receives the new playlist.

Finally, the applicants have had to describe a playlist, a playlist server, and a playlist response in terms that “enable any person skilled in the art” to make and use the invention of the claims rejected for anticipation by Marsh. However, Marsh’s description of a message scheduling method and apparatus omits any “terms” describing these elements and therefore also fails to enable the invention of these claims.

Accordingly, for omission of elements and for failure to enable the recited invention, Marsh does not anticipate claims 1, 3-7, 19, 20, 24, 25, and 93-98 and the rejection should be withdrawn.

Claims 21-23, 26-28, 31, 32, 65, 93-101, 130-133, 135-143 and 169-174 are rejected for obviousness over Marsh. The applicants respectfully traverse this rejection for the following reasons.

With respect to all of these claims Marsh lacks a “playlist”, a “playlist server”, and a “playlist response” for reasons given above.

With respect to claims 21-23 and 99-101, the playlist response generated by the playlist server comprises a new playlist, the client device employs a plurality of current playlists, and “at least one of the selected ads is deleted from the current playlists when the client device receives the new playlist.” The contention in the Office Action is that since it is known to delete unneeded information from a database, it would have been obvious to have “included deleting from storage advertisements that are not included in the playlist” in order to “free the database of unnecessary information.” The applicants note that the rejected claims are directed to list maintenance, not to clearing a “database” or “storage.” Marsh does not describe any “playlist”, any client device that “employs a plurality of current playlists”, or deletion of any ad from any list transmitted by a server. Accordingly, the applicants respectfully request citation of a reference or entry of an examiner’s affidavit to establish that claims 21-23 and 99-101 are *prima facie* obvious over Marsh, or withdrawal of this rejection.

With respect to claims 26-32 the playlist server further comprises a “playlist request parsing means for extracting selected information from the playlist request,” and “selected information supply means for supplying the selected information to the playlist generating means to thereby initiate the playlist generating means.” The contention in the Office Action is that since it is known to parse and extract selected information, it would have been obvious to have “included parsing means for extracting relevant information from the playlist” in order to ensure that only relevant information remains. The applicants note that Marsh does not describe any “playlist request”, or any “playlist generating means” capable using “selected information” parsed from a playlist request. Accordingly, the applicants respectfully request citation of a reference or entry of an examiner’s affidavit to establish that claims 26-32 are *prima facie* obvious over Marsh, or withdrawal of this rejection.

With respect to claims 65, 126, 130, 131, and 135, in addition to the omissions noted above, Marsh fails to teach or suggest other elements and limitations of these claims. The contention in the Office Action is that since XML format is well known it would have been obvious to have included XML to verify that a playlist request is well formed to render it accessible to a variety of clients and applications. However, these claims comprehend combinations of many elements and limitations in addition to XML. For example, these claims include “extensible markup language (XML) parsing means”, “playlist analysis means”, “database driver means receiving the object for building a query”, “playlist generating means”, and “selected information supply means”. None of these additional elements is suggested by the “well known XML format”. Accordingly, the applicants respectfully request citation of a reference or entry of an examiner’s affidavit to establish that claims 65, 126, 130, 131, and 135 are *prima facie* obvious over Marsh, or withdrawal of this rejection.

With respect to claims 133 and 136 the “client information” includes “a user data field identifying the respective software operating on the client device” (claim 133) and “usage data relating to the amount of time the user has used the client device over a prescribed time interval” (claim 136). The contention in the Office Action is that Marsh teaches a user activity monitor function that monitors user activity such as use over a prescribed time period at col. 15, lines 14-18. This passage does not teach or suggest a “user data field identifying the respective software operating on the client device”. All that is described is an event log file containing information about various actions taken by the user. However, no prescribed time interval of any kind is taught or suggested in the cited

passage of Marsh. Accordingly, the applicants respectfully request citation of a reference or entry of an examiner's affidavit to establish that claims 132, 133, and 136 are *prima facie* obvious over Marsh, or withdrawal of this rejection.

With respect to claim 137, the contention is that Marsh teaches customizing a new playlist to a client device at col. 15, lines 31-53. In fact, Marsh only describes an advertisement distribution scheduler that generates an assignment of advertisements to clients. The "assignment" is not described as a "playlist", nor is it described as having the attributes of a playlist that are set forth in the definition of a playlist in this specification. Furthermore, the "assignment" that is generated is not provided to a client; only advertisements are provided to a client. Accordingly, the applicants respectfully request citation of a reference or entry of an examiner's affidavit to establish that claim 137 is *prima facie* obvious over Marsh, or withdrawal of this rejection.

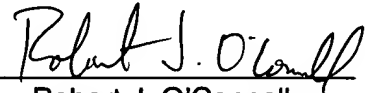
With respect to claims 138-143, the "selected information" includes "a display time remaining data field that specifies the total amount of display time required for the stored ads that remain to be presented by the client device." The contention in the Office Action is that since the scheduler 700 of Marsh arranges the sequence and order of ads it would have been obvious to specify a total time for ad viewing to determine if the client had complied with a daily total of ads he or she is supposed to view. A diligent reading of Marsh has failed to identify any "daily quota" of ads that a viewer is supposed to view. Accordingly, there is no motivation to add this parameter to the other statistics that the scheduler 700 keeps. The applicants therefore respectfully request citation of a reference or entry of an examiner's affidavit to establish that claims 138-143 are *prima facie* obvious over Marsh, or withdrawal of this rejection.

With respect to claims 169-171 and 172-174, for reasons given above, Marsh lacks a "playlist", a "new playlist", and a "current playlist". See also the remarks in traversal of this rejection with respect to claims 3-7, 19, 20, and 93-98. The applicants therefore respectfully request citation of a reference or entry of an examiner's affidavit to establish that claims 169-171 and 172-174 are *prima facie* obvious over Marsh, or withdrawal of this rejection.

In view of these remarks, it is submitted that all pending claims in this application are patentably distinguishable from the references of record. Accordingly, reconsideration of the rejection and allowance of the application are earnestly requested. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

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